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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/602,475

06/23/2003

Harry J. Klee

UF-325XCI

2685

23557

7590

02/28/2007

SALIWANCHIK LLOYD & SALIWANCHIK

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EXAMINER

KALLIS, RUSSELL

ART UNIT

PAPER NUMBER

1638

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/602,475

Applicant(s)

KLEE ET AL.

Examiner

Russell Kallis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,14,15,17,19,20,27-31,33,35,36,43-46 and 57-65 is/are pending in the application.
- 4a) Of the above claim(s) 57-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,14,15,17,19,20,27-31,33,35,36 and 43-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Rejection of Claims 1-6, 10, 14-20, 24, 27-36, 40 and 43-46 under 35 U.S.C. 102(e) is withdrawn in view of Applicant's amendments.

New claims 57-65 are withdrawn as being drawn to a non-elected sequences.

Claims 2, 4, 7-13, 16, 18, 21-26, 32, 34, 37-42 and 47-56 are canceled.

Claims 1, 3, 5-6, 14-15, 17, 19-20, 27-31, 33, 35-36 and 43-46 are pending and examined.

Claim Rejections - 35 USC § 103

Claims 1, 3, 5-6, 14-15, 17, 19-20, 27-31, 33, 35-36 and 43-46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,294,716 issued 25th of September 2001 in view of Hudspeth R. *et al.* Plant Molecular Biology, 1996, Vol. 31; pp. 911-916. This rejection is maintained for the reasons of record set forth in the Official action mailed 8/10/2006.

Applicant's arguments filed 11/17/2006 have been considered but are not deemed persuasive.

Applicant asserts that the references together or alone do not teach or suggest Applicant's claimed invention; that the '716 Patent does not teach or suggest the instantly claimed invention and that the '716 Patent does not teach the instantly claimed SEQ ID NO: 5 that encodes the amino acid sequence of SEQ ID NO: 1 (response page 8).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant's attention is directed to Claim 25 of the '716 Patent which recites, "The plant according to claim 23 wherein said modified ETR protein comprises the substitution of a selected amino acid residue with a different amino acid, wherein said selected amino acid residue is equivalent to an amino acid residue selected from the group consisting of Ala-31, Pro-36, Ile-62, Cys-65 and Ala-102 in the ETR protein sequence of *Arabidopsis thaliana*." It would have been obvious to make substitutions at the same positions as those recited in the '716 Patent.

Applicant asserts that the Hudspeth reference does not teach or suggest SEQ ID NO: 8 (response page 9). The Hudspeth reference does suggest SEQ ID NO: 8 because not only does it teach the first 450 nucleotides of the promoter but also provides motivation to further isolate the remaining portions of the 5' flanking regions that regulate gene expression in response to chemical and fungal attack on page 915 column 2 last paragraph and because one of ordinary skill in the art would have appreciated that the remaining portions of the promoter taught by Hudspeth (i.e. SEQ ID NO: 8) lay within the isolated genomic clones shown in Figure 5A on page 914. Furthermore, One of ordinary skill in the art would have been motivated by the teachings of both U.S. Patent 6,294,716 and Hudspeth that promoters induced by ethylene are useful in the art of genetic engineering of plants, that abscission in plants is controlled by ethylene as taught by U.S. Patent 6,294,716, that the cotton chitinase gene is induced by ethylene, and that one of ordinary skill in the art would have a reasonable expectation of success in further isolating and utilizing the functional portion of the promoter taught by Hudspeth to decrease the response to ethylene in plant tissue and thereby reducing the ethylene regulated

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process of abscission in plants thereby decreasing fruit, leaf or flower drop in a plant, wherein the choice of a functional fragment of SEQ ID NO: 8 or a larger or “full length” chitinase promoter is an obvious design choice given the lack of criticality.

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Russell Kallis Ph.D.
February 16, 2007

RUSSELL P. KALLIS, PH.D.
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Russell Kallis".